

### **Remarks**

The Office Action mailed June 6, 2005 has been carefully reviewed and the foregoing amendment and following remarks have been made in consequence thereof.

In accordance with 37 C.F.R. 1.136(a), a two month extension of time is submitted herewith to extend the due date of the response to the Office Action dated June 6, 2005 for the above-identified patent application from September 6, 2005, through and including November 7, 2005 (November 6, 2005 was a Sunday). In accordance with 37 C.F.R. 1.17(a)(2), authorization to charge a deposit account in the amount of \$450.00 to cover this extension of time request is also submitted herewith.

Claims 1-17 and 19-21 are now pending in this application. Claim 18 has been canceled. Claims 2, 5, 6, 10, 12, 13, 16, 17, 20, and 21 stand rejected. Claim 19 stands objected to. Claims 1, 3, 4, 7-9, 11, 14, and 15 have been allowed.

The rejection of Claims 2, 5, 6, 10, 12, and 13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is respectfully traversed.

More specifically, Claim 2 has been amended to recite “calendaring the substrate after the step of providing a substrate and before the step of treating the substrate.” Additionally, Claims 5 and 12 have been amended to recite “pleating the treated substrate after the step of curing the treated substrate.” Claim 6 depends from Claim 5, and Claim 13 depends from Claim 12. Moreover, Claim 10 has been amended to delete “glass” from the group the polymer substrate is selected from.

For at least the reasons set forth above, Claims 2, 5, 6, 10, 12, and 13 are submitted to satisfy the requirements of 35 U.S.C. § 112.

Accordingly, Applicant respectfully requests the Section 112 rejection of Claims 2, 5, 6, 10, 12, and 13 be withdrawn.

The objection to the specification is respectfully traversed.

More specifically, the priority statement has been updated to reflect the issuance of U.S. Patent Application No. 10/000,236 as U.S. Patent No. 6,752,847. Additionally, paragraph number [0032] has been enlarged, and paragraph [0051] has been amended to delete “of Figure 8”. Moreover, paragraph number [0056] has been amended to spell out “equivalents”.

For at least the reasons set forth above, Applicant respectfully requests the objection to the specification be withdrawn.

In the Office Action Summary, the Examiner has indicated that the drawings filed on March 17, 2004 are objected to. However, no specific objection is stated in the Office Action. Accordingly, Applicant respectfully request the objection to the drawings be withdrawn.

The rejection of Claims 16, 17, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over European Patent Application No. EP 0 726 348 (Wyss) in view of U.S. Patent No. 4,454,189 (Fukata) or European Patent Application No. EP 1 096 057 (Makoto) is respectfully traversed.

Claim 16 recites a method of making a filter medium for use in a filtering application at an application temperature, wherein the method comprises, among other things, “providing a substrate...calendering the substrate...providing a polyimide stiffening agent selected from the group consisting of polyetherimides and polybismaleimides...treating the calendered substrate with the polyimide stiffening agent....”

None of Wyss, Fukata, or Makoto, considered along or in combination, describe or suggest a method of making a filter medium for use in a filtering application at an application temperature, wherein the method includes providing a substrate, calendering the substrate, providing a polyimide stiffening agent selected from the group consisting of polyetherimides

and polybismaleimides, and treating the calendered substrate with the polyimide stiffening agent. Rather, Wyss describes a stiffening agent that includes polyamideimides, but does not describe or suggest a polyimide stiffening agent selected from the group consisting of polyetherimides and polybismaleimides. Neither Fukata nor Makoto, considered alone or in combination, make up for the deficiencies of Wyss. For at least the reasons set forth above, Claim 16 is submitted as patentable over Wyss in view of Fukata or Makoto.

Claims 17, 20, and 21 depend from independent Claim 16. When the recitations of Claims 17, 20, and 21 are considered in combination with the recitations of Claim 16, Applicant submits that dependent Claims 17, 20, and 21 likewise are patentable over Wyss in view of Fukata or Makoto.

For the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 16, 17, 20, and 21 be withdrawn.

Moreover, Applicant respectfully submits that the Section 103 rejection of presently pending Claims 16, 17, 20, and 21 is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to combine Wyss, Fukata, and/or Makoto. More specifically, it is respectfully submitted that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant.” In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicant’s disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant’s disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicant requests that the Section 103 rejection of Claims 16, 17, 20, and 21 be withdrawn.

Claims 2, 5, and 6 were indicated in the Office Action as being allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in the Office Action and to include all of the limitations of the base claim and any intervening claims. Claims 2, 5, and 6, as amended, are submitted to satisfy the requirements of 35 U.S.C. § 112 and depend, directly or indirectly, from independent Claim 1, which is submitted to be in condition for allowance. When the recitations of Claims 2, 5, and 6 are considered in


combination with the recitations of Claim 1, Applicant submits that dependent Claims 2, 5, and 6 likewise are in condition for allowance.

Claims 10, 12, and 13 were indicated in the Office Action as being allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in the Office Action and to include all of the limitations of the base claim and any intervening claims. Claims 10, 12, and 13, as amended, are submitted to satisfy the requirements of 35 U.S.C. § 112 and depend, directly or indirectly, from independent Claim 9, which is submitted to be in condition for allowance. When the recitations of Claims 10, 12, and 13 are considered in combination with the recitations of Claim 9, Applicant submits that dependent Claims 10, 12, and 13 likewise are in condition for allowance.

Claim 19 was indicated in the Office Action as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 19 depends from independent Claim 16, which is submitted to be in condition for allowance. When the recitations of Claim 19 are considered in combination with the recitations of Claim 16, Applicant submits that dependent Claim 19 likewise is in condition for allowance.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'CHL', is written over a horizontal line.

Charles H. Livingston  
Registration No. 53,933  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740  
(314) 621-5070